

REMARKS

This amendment is responsive to the outstanding Office Action in this application mailed January 27, 2004. In that Office Action, the Examiner rejected all of the claims on the prior art and indicated that each of the declarations were insufficient to overcome those rejections.

At the outset, applicant thanks Examiners Rhee and Ahmad for the telephone interview conducted on May 18, 2004. As discussed in the interview, the Talbot *et al.* reference is a trim piece for interior applications. Exposure of wood veneer—like that in Talbot *et al.*—to the elements results in checking and fiber separation. In other words, wood veneer degrades rapidly outside. In addition, the Talbot *et al.* invention utilizes polyvinyl acetate glue. Talbot *et al.*, col. 2, ln. 40. This glue is not at all suitable for materials exposed to weather.

Although the Robbins reference discloses a single sheet of paper glued to a veneer face on a piece of structural lumber, it does not follow that it would be obvious to utilize paper instead of wood veneer in Talbot *et al.* which, again, is interior trim.

Finally, the Hoffman reference discloses an engineered wood product used as exterior trim. This product is very similar to applicant's prior art product, which is described in the application and in the Johnson Declaration. In short, both Hoffman and applicant's prior art product utilize LVL lumber having sanded and filled edges. This edge treatment is to improve both appearance and weather resistance, which are both noted as problems with plywood trim in Hoffman, col. 1, ln. 31 *et seq.*

But these problems were not resolved by applicant's prior art product nor by the Hoffman product. The extent of these problems are set forth in paragraphs 6-8 of the Johnson Declaration and can be seen in photo exhibits B, C, D, and E attached to the Johnson Declaration and described in paragraphs 9 and 10. In fact, these problems were so extensive that customers refused to buy the prior art Hoffman-type product from applicant. Sanregret Declaration, ¶ 5; Caylor Declaration, Ex. A.

There are three factors listed in MPEP § 716.04 as indicating long-felt need:

- The need must have been a persistent one that was recognized by those of ordinary skill in the art;
- The need must not have been satisfied by another before the invention by applicant; and
- The invention must satisfy the long-felt need.

To sum up concerning long-felt need, the problems—namely drawbacks in appearance and maintenance—associated with using engineered wood as trim were recognized in Hoffman, which was filed on March 17, 1989. As can be seen in paragraphs 6-8, these problems continued with the applicant's prior art Hoffman-type product starting about 1995 through at least October, 2003, when the Johnson Declaration was executed.

Finally, both the Caylor and Sanregret declarations recite that customers who would not purchase the old Hoffman-type product would buy the new product. Put differently, product constructed in accordance with applicant's invention satisfied the need.

Further, the Caylor and Sanregret declarations indicate some evidence of commercial success, at least to the extent that applicant was able make sales of the trim constructed in accordance with the invention to customers who would not buy the prior art trim.


Another form of secondary evidence of nonobviousness is evidence of copying. MPEP § 716.06. Applicant's product has apparently been copied. Johnson Declaration, ¶ 18.

These declarations consequently should be given weight as evidence of the secondary considerations of long-felt need, commercial success, and copying.

Even though, for the above reasons, applicant believes that the claims are patentable over the prior art, especially in view of the declarations, each of the remaining independent claims has been amended to clarify the invention. Specifically, the claims are amended to state that the product is for exterior trim on the exterior of a building. In contrast, Talbot *et al.* is used as interior trim and Robbins is used as structural lumber. In view of this new limitation and the above argument indicating how the declarations demonstrate the secondary considerations of long-felt need, commercial success, and copying, applicant requests reconsideration of the claims as amended.

Respectfully submitted,

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